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AUG 05 2009

OFFICE OF PETITIONS

In re Application of :
Bratzler et al. :
Application No. 09/776,479 :
Filed: February 2, 2001 :
Attorney Docket No. :
C1037/7013 (HCL/MAT) :

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. § 1.705(B) filed June 8, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is six hundred forty seven (647) days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

This application for patent term adjustment was timely filed with payment of the Issue Fee on June 8, 2009. As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **GRANTED** to the extent indicated herein.

On March 6, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. The instant application for patent term adjustment was timely filed on June 8, 2009, with payment of the issue fee.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Applicants contend that a 94-day reduction for the submission of the supplemental reply in the form of an Information Disclosure Statement (IDS) on February 23, 2009 is warranted. Pursuant to 37 CFR § 1.704(c), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

A review of the record confirms that the supplemental reply, in the form of the IDS, was not requested by the examiner. The IDS was submitted after the reply to the non-final Office action on November 21, 2008. Accordingly, the period of reduction of 94 days is required.

Thus, the total calculation for applicant delay prior to the mailing of the Notice of Allowance is 683 days.

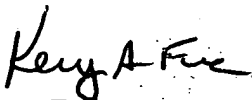
In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 0 days (330 days of Office delay reduced by 683 (35 + 17 + 95 + 61 + 95 + 95 + 95 + 96 + 94) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.



Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration



PALM INTRANET

Day : Sunday
Date: 8/2/2009
Time: 12:29:29

PTA Calculations for Application: 09/776479

Application Filing Date:	02/02/2001	PTO Delay (PTO):	330
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	596
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-94		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
120	08/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		94	
105	03/06/2009	MAIL NOTICE OF ALLOWANCE			
104	03/04/2009	ISSUE REVISION COMPLETED			
103	02/23/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
102	02/17/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
101	02/17/2009	DOCUMENT VERIFICATION			
100	08/15/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
99	02/17/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
98	02/17/2009	NOTICE OF ALLOWABILITY			
97	11/28/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
96	11/24/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
95	11/28/2008	REFERENCE CAPTURE ON IDS			
94	11/28/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		7	90
93	11/24/2008	REFERENCE CAPTURE ON IDS			
92	11/24/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
91	12/04/2008	DATE FORWARDED TO EXAMINER			
90	11/21/2008	RESPONSE AFTER NON-FINAL ACTION			
89	11/28/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
88	11/24/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

87	09/15/2008	MISCELLANEOUS INCOMING LETTER			
86	08/21/2008	MAIL NON-FINAL REJECTION			
85	08/18/2008	NON-FINAL REJECTION			
84	11/05/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
83	06/03/2008	DATE FORWARDED TO EXAMINER			
82	04/24/2008	RESPONSE AFTER NON-FINAL ACTION		96	77
81	04/24/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
80	11/05/2007	REFERENCE CAPTURE ON IDS			
79	11/05/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	11/05/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
77	10/19/2007	MAIL NON-FINAL REJECTION			
76	10/15/2007	NON-FINAL REJECTION			
75	07/30/2007	DATE FORWARDED TO EXAMINER			
74	07/23/2007	RESPONSE AFTER NON-FINAL ACTION		95	72
73	07/23/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
72	01/19/2007	MAIL NON-FINAL REJECTION			
71	01/08/2007	NON-FINAL REJECTION			
70	11/06/2006	DATE FORWARDED TO EXAMINER			
69	10/30/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
68	11/06/2006	DATE FORWARDED TO EXAMINER			
67	10/30/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)		95	63
66	11/06/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
65	10/30/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
64	10/30/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
63	04/27/2006	MAIL FINAL REJECTION (PTOL - 326)			
62	04/26/2006	FINAL REJECTION			
61	01/30/2006	DATE FORWARDED TO EXAMINER			
60	01/09/2006	RESPONSE AFTER NON-FINAL ACTION		95	58
59	01/09/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	07/06/2005	MAIL NON-FINAL REJECTION			

57	06/27/2005	NON-FINAL REJECTION			
56	04/15/2005	DATE FORWARDED TO EXAMINER			
55	04/06/2005	RESPONSE AFTER NON-FINAL ACTION		61	53
54	04/06/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
53	11/04/2004	MAIL NON-FINAL REJECTION			
52	11/01/2004	NON-FINAL REJECTION			
51	08/25/2004	DATE FORWARDED TO EXAMINER			
50	08/18/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
49	08/18/2004	WORKFLOW INCOMING AMENDMENT IFW			
48	07/14/2004	MAIL RESTRICTION REQUIREMENT			
47	07/12/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
46	04/09/2004	DATE FORWARDED TO EXAMINER			
45	03/29/2004	RESPONSE AFTER NON-FINAL ACTION		95	36
44	03/29/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
43	02/17/2004	IFW AMENDED CASE PROCESSING COMPLETE			
41	01/27/2004	MISCELLANEOUS INCOMING LETTER			
40	12/29/2003	MAIL-PETITION DECISION - GRANTED			
39	07/11/2003	PETITION ENTERED			
38	07/17/2003	REFERENCE CAPTURE ON IDS			
37.7	07/17/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		17	32
37	07/17/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	09/25/2003	MAIL NON-FINAL REJECTION			
35	09/22/2003	NON-FINAL REJECTION			
34	07/15/2003	CASE DOCKETED TO EXAMINER IN GAU			
33	07/07/2003	DATE FORWARDED TO EXAMINER			
32	06/30/2003	RESPONSE TO ELECTION / RESTRICTION FILED		35	30
31	06/30/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	02/26/2003	MAIL RESTRICTION REQUIREMENT	330		-1
29	02/24/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
28	02/24/2003	APPLICATION RETURN FROM OIPE			
26	08/21/2002	APPLICATION IS NOW COMPLETE			
24	07/29/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
		A STATEMENT BY ONE OR MORE INVENTORS			

23	07/29/2002	SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
22	08/12/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
21	06/18/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
20	06/18/2002	PRE-EXAM OFFICE ACTION WITHDRAWN			
18	05/15/2002	APPLICATION RETURN TO OIPE			
17	03/20/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
16.7	01/14/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	01/14/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	01/08/2002	PRELIMINARY AMENDMENT			
14	02/28/2002	X-PRE-LEGAL COMPLETE NEW CASE			
13	02/28/2002	CASE DOCKETED TO EXAMINER IN GAU			
12	01/31/2002	APPLICATION DISPATCHED FROM OIPE			
11	01/29/2002	APPLICATION IS NOW COMPLETE			
9	10/11/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
8	10/10/2001	CORRESPONDENCE ADDRESS CHANGE			
7	10/09/2001	CASE FOUND			
6	10/09/2001	TERMINATION OF OFFICIAL SEARCH			
5	10/03/2001	OFFICIAL SEARCH CONDUCTED			
4	10/03/2001	CASE REPORTED LOST			
3	02/23/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	02/02/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	02/02/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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